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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,348	07/30/2001	Shoji Suzuki	N9450.0023/P023	9150

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EXAMINER
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SCHUBERT, KEVIN R

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/916,348	Applicant(s) SUZUKI ET AL.	
	Examiner Kevin Schubert	Art Unit 2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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**DETAILED ACTION**

Claims 1-9 have been considered.

***Claim Rejections - 35 USC § 102***

5           The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

10           (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15           Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Bonnaure, U.S. Patent No. 5,862,339.

As per claims 1-5, the applicant describes a home server with the following limitations which are met by Bonnaure:

20           a) telephone number coincidence-checking means for determining whether or not it can be accepted to perform said requirement sent from the sending source, said telephone number coincidence-checking means includes means which do not hinder the operation of other telephone equipment including a fax telephone and using a common telephone line connected to said home server (Col 5, lines 45-63);

            b) modem means for receiving said requirement, which has been accepted by said telephone number coincidence-checking means (Col 8, lines 32-47; Fig 10; Fig 5);

25           c) protocol-processing means for converting a signal of said requirement received by said modem means to an internet service requirement (Col 8, lines 32-47);

            d) internet service-offering means for offering said internet service to said sending source in response to said internet service requirement, which has been converted by said protocol-processing means (Col 8, lines 32-47);

Art Unit: 2137

e) control means for controlling concerned equipment in said home which is needed to offer said internet service by said internet service-offering means (Col 8, lines 32-47; Col 4, lines 49-64);

The WebTV server, or home server, receives a requirement from the set top box, or sending source, via a communication line through the internet for an internet service connection (Fig 6). If authenticated, the WebTV server offers the internet service connection and controls equipment on the WebTV server for allowing the client access to its services over the internet (Col 4, lines 49-64). The protocol-processing means is done by the network interface (Fig 10) which converts the signal from the set top box requesting an internet connection to and services from the WebTV server.

As per claim 6, the applicant describes an internet service system with the home server according to claim 1, which is met by Bonnaure (see above), with the following limitations which are also met by Bonnaure:

- a) an information terminal for requiring an internet service (Fig 6);
- b) a communication line for transmitting said internet service (Fig 6; Col 6, lines 30-39);
- c) a home server according to claim 1, for receiving said transmitted internet service (claim 1);
- d) wherein said internet service can be implemented by said information terminal (Fig 6);

Regarding part a), the information terminal is the WebTV client (610 of Fig 6), or set top box. The WebTV client requires an internet service between it and the WebTV server (620 of Fig 6).

Regarding part d), the internet service is implemented by the information terminal (WebTV client), but no communication exists between the WebTV client and the WebTV server unless the WebTV server authenticates the WebTV client by checking his telephone number in the registry.

As per claim 7, the applicant describes an internet service system with the home server according to claim 1, which is met by Bonnaure (see above), with the following limitations which are also met by Bonnaure:

- a) an internet for transmitting an internet service required from a sending source (Fig 6);

Art Unit: 2137

b) a service provider which receives said internet service from said internet, and implements said connection between said sending source and a receiving destination to which said sending source intends to connect (Fig 6);

c) a communication line for transmitting said internet service (Col 6, lines 30-39);

5 d) a home server according to claim 1, which receives said sent internet service (claim 1);

e) wherein said internet service can be implemented from said internet (Fig 6);

Regarding part a), as described earlier, the WebTV server is the home server and the WebTV client is the sending source.

10 Regarding part b), the conventional network (612 of Fig 6) comprises service providers which allow for the internet connection between the WebTV client and the WebTV server.

Regarding part e), as seen in Fig 6, the communication between the WebTV client and the WebTV server takes place over the internet.

15 As per claim 8, the applicant describes the home server of any one of claims 1-5, which are met by Bonnaure (see above), with the following additional limitation which is also met by Bonnaure:

Wherein said sending source comprises a calling-up person or a machine (Fig 6);

As described earlier, the sending source is the WebTV client, which is a machine.

20 As per claim 9, the applicant describes the home server of any one of claims 1-4, which are met by Bonnaure (see above), with the following additional limitation which is also met by Bonnaure:

Wherein said telephone number coincidence-checking means comprises a unit for confirming on a registration of a telephone number corresponding to a telephone accessing said home server (Col 5, lines 45-63);

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### ***Response to Arguments***

Applicant's arguments, see Remarks filed 5/25/05, have been fully considered but they are not persuasive. The applicant argues that Bonnaure does not disclose "said telephone number coincidence-

Art Unit: 2137

checking means includes means which do not hinder the operation of other telephone equipment" as disclosed in claim 1. The examiner disagrees. The telephone number coincidence-checking means has means to reject a connection if a client is not authenticated by telephone number coincidence-checking means (see 1314, 1316, and 1318 of Fig 13). Means which reject a connection and eliminate busy  
5 telephone line are means which do not hinder the operation of other telephone equipment

Secondly, Bonnaure never even discloses that other telephone equipment use the telephone line used by the WebTV. In fact, Bonnaure discloses that the WebTV may have a dedicated line (Col 6, lines 37-39). By having a dedicated line, the WebTV cannot possibly interrupt other telephone equipment.

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### **Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH  
shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX  
MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Schubert whose telephone number is (571) 272-4239. The examiner can normally be reached on M-F 7:30-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2137

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should  
5 you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KS

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*Matthew D. Smithers*  
MATTHEW SMITHERS  
PRIMARY EXAMINER  
*Art Unit 2137*